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PART B - FEE(S) TRANSMITTAL

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|   |                    |
|---|--------------------|
| <b>OMKAR SURYADEVARA</b><br><i>S. Omkar</i> | (Depositor's name) |
| <b>December 13, 2004</b>                    | (Date)             |

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/849,005      | 05/04/2001  | Chian-Min Richard Ho | M-5333-1C US        | 1848             |

TITLE OF INVENTION: METHOD FOR AUTOMATICALLY SEARCHING FOR FUNCTIONAL DEFECTS IN A DESCRIPTION OF A CIRCUIT

| APPLN. TYPE           | SMALL ENTITY | ISSUE FEE                       | PUBLICATION FEE | TOTAL FEE(S) DUE                | DATE DUE   |
|-----------------------|--------------|---------------------------------|-----------------|---------------------------------|------------|
| nonprovisional        | NO           | <del>\$1330</del> <b>\$1400</b> | \$0             | <del>\$1330</del> <b>\$1400</b> | 12/13/2004 |
| EXAMINER              | ART UNIT     | CLASS-SUBCLASS                  |                 |                                 |            |
| FREJD, RUSSELL WARREN | 2128         | 703-014000                      |                 |                                 |            |

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

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2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,  
(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

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3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

**MENTOR GRAPHICS CORPORATION**

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

**WILSONVILLE, OREGON**

Please check the appropriate assignee category or categories (will not be printed on the patent):  Individual  Corporation or other private group entity  Government

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Issue Fee  
 Publication Fee (No small entity discount permitted)  
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4b. Payment of Fee(s):

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 Payment by credit card. Form PTO-2038 is attached.  
 The Director is hereby authorized to charge the required fee(s) or credit any overpayment, to Deposit Account Number **50-2263** (enclose an extra copy of this form). *any underpaid fee*

5. Change in Entity Status (from status indicated above)

a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.  b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above. NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature

*S. Omkar*

Typed or printed name **OMKAR SURYADEVARA**

Date **Dec. 13, 2004**

Registration No. **36,320**

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Inventor: Chian-Min, Richard Ho  
Title: Method for automatically searching for defects in a description of a circuit  
Serial No.: 09/849,005 Filing Date: May 4, 2001  
Examiner: Frejd, Russell Warren Group Art Unit: 2123  
Docket No.: 0IN006-1C US Confirmation No.: 1848

Santa Clara, California  
December 13, 2004

COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Dear Sir:

This paper is timely submitted because it is filed with issue fee payment for the above-identified patent application.

In the Notice of Allowability mailed on September 13, 2004, the Examiner stated, in a section entitled "Reasons for Allowance", that the instant application is directed to a non-obvious improvement over US Patent 5,729,554. The Examiner further stated (at the top of page 2) that the improvement comprises a method for determining defects ... whereby the transition from the current state to the second next state is performed automatically after the transition to the first next state without entering a reset state. This patentable distinction is included in each of the independent claims, nos. 11, 16, 27, 29-31, 33, 42, 44, 48-53, 57, 62, 64, and 69."

Applicants respectfully traverse that the Examiner's reasons for allowance as being incorrect, for at least the following reason. Specifically, the limitation "transition ... without entering a reset state" is not present (either explicitly or implicitly) in Claims 27, 29, 30, 31, 33, 44, 48-53, 57, 62, 64 and 69. In fact the word "reset" is not present in any of Claims 29, 30, 31, 33, 44, 48-53, 57, 62, 64 and 69. Although the word "reset" is used in Claim 27, this

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claim merely requires the current state to be non-reset, without specifying whether or not the reset state may be entered when restoring the simulation.

Applicants submit that Claims 27, 29, 30, 31, 33, 44, 48-53, 57, 62, 64 and 69 (and any claims that depend therefrom) are to be interpreted broadly to cover transitions with or without entering the reset state, because this limitation is not cited therein. To the extent the Examiner believes that such broadly-interpreted claims are not allowable over the prior art of record, the Examiner is invited to re-open prosecution on the merits, as per MPEP §1308.01.

In addition, the Examiner attached only a single page IDS to the Notice of Allowability, although Applicants addressed the Examiner's objection to a 24-sheet Part B IDS in the Amendment dated April 28, 2004 (see bottom of page 23 and top of page 24 of this Amendment). In view of allowance of the current patent application Applicants believe that the Examiner has withdrawn his objection to the 24-sheet IDS. Hence, all references in these 24 sheets are believed to have been considered for their relevance to the patentability of the allowed claims. If these references were not considered for any unknown reason, the Examiner is invited to re-open prosecution on the merits, as per MPEP §1308.01.

Should the Examiner have any questions concerning this response, the Examiner is invited to call the undersigned at (408) 982-8200, ext. 3.

**Via Express Mail Label No.  
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Respectfully submitted,

  
\_\_\_\_\_  
Omkar K. Suryadevara  
Attorney for Applicants  
Reg. No. 36,320

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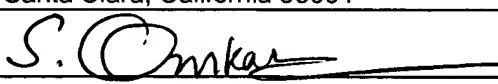
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|  |   |                     |                       |
|--|---|---------------------|-----------------------|
|  |   | Application Number  | 09/849,005            |
|  |   | Filing Date         | May 4, 2001           |
|  |   | First Inventor      | Chian-Min Richard Ho  |
|  |   | Confirmation No.    | 1848                  |
|  |   | Group Art Unit      | 2123                  |
|  |   | Examiner Name       | Frejd, Russell Warren |
| Total Number Of Pages In This Submission   | 5 | Attorney Docket No. | 0IN006-1C US          |

## ENCLOSURES (check all that apply)

|  |   |  |  |         |
|--|---|--|--|---------|
| <input checked="" type="checkbox"/> Issue Fee Transmittal Form – PTOL-85 PART B (1 page)                       | <input type="checkbox"/> Assignment Papers (for an Application)   | <input type="checkbox"/> After Allowance Communication to Group                            |  |         |
| <input checked="" type="checkbox"/> Fee Attached: Check (1 page)   | <input type="checkbox"/> Drawing(s)   | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences        |  |         |
| <input checked="" type="checkbox"/> Comments on Statement of Reasons For Allowance                             | <input type="checkbox"/> Licensing-related Papers   | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |  |         |
| <input checked="" type="checkbox"/> After Final (2 pages)  | <input type="checkbox"/> Petition   | <input type="checkbox"/> Proprietary Information   |  |         |
| <input type="checkbox"/> Affidavits/declarations   | <input type="checkbox"/> Petition to Convert to a Provisional Application                                       | <input type="checkbox"/> Status Letter   |  |         |
| <input type="checkbox"/> Extension of Time Request   | <input type="checkbox"/> Power of Attorney, Revocation of Previous Powers; And Statement Under 37 CFR 3.73(b)   | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):            |  |         |
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| <input type="checkbox"/> Certified Copy of Priority Document(s)  | <input type="checkbox"/> CD, Number of CD(s) _____  |  |  |         |
| <input type="checkbox"/> This is a Response to Missing Parts/ Incomplete Application under 37 CFR 1.52 or 1.53 | <table border="1" style="width: 100px; margin-left: auto; margin-right: 0;"> <tr><td>Remarks</td></tr> </table> |  |  | Remarks |
| Remarks  |   |  |  |         |
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## SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

|                         |   |
|-------------------------|---|
| Firm or Individual Name | Omkar K. Suryadevara (Reg. No. 36,320)<br>Silicon Valley Patent Group LLP<br>2350 Mission College Boulevard, Suite 360<br>Santa Clara, California 95054 |
| Signature               |    |
| Date                    | December 13, 2004   |

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